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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,509	09/10/2003	Ronald J. Nachman	0166.03	3643

25712 7590 06/16/2005

USDA-ARS-OFFICE OF TECHNOLOGY TRANSFER  
NATIONAL CTR FOR AGRICULTURAL UTILIZATION RESEARCH  
1815 N. UNIVERSITY STREET  
PEORIA, IL 61604

EXAMINER

BORIN, MICHAEL L

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/659,509

Applicant(s)

NACHMAN ET AL.

Examiner

Michael Borin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

5-0-0

### **DETAILED ACTION**

Claims 1-40 are currently pending.

#### **Restriction Requirement**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to first group of products, classified in class 530, in general.
- II. Claims 20-33, drawn to second group of products, classified in class 530, in general.
- III. Claims 38, 39, drawn to third group of products, classified in class 530, in general.
- IV. Claims 16-19, drawn to method of use of the first group of products, classified in class 514, in general.
- V. Claims 34-37, drawn to method of use of the second group of products, classified in class 514, in general.
- VI. Claim 40, drawn to method of use of the third group of products, classified in class 514, in general.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I-III are patentably distinct from each other because of the materially different structures of the compounds they are claiming. The compounds of Group I have  $R_1-L_m-X_4$  moiety not required for compounds of Group II; Groups II and III have  $X_a-X_b$  moiety, not required for Group I, Group II has  $R'$  moiety (e.g.,

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hydrocinnamyl, hydroxycinnamic acyl) not required for Groups I and III. The inventions are drawn to independent and/or patentably distinct peptides since each would be expected to possess distinctly different structure (e.g., amino acid content, secondary and tertiary structure), and/or physico-chemical properties, and/or capable of separate manufacture and/or use. The correspondent methods of use (Groups IV-VI) are independent and/or distinct due to the use of different patentably distinct agents.

Inventions I and IV, II and V, III and VI are related as products and processes of use, respectively. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different processes such as peptide synthesis, and the method of use can be practiced with a variety of insecticides drugs the claimed compounds.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art because of their recognized divergent subject matter, the sequence or structure search required for different groups is different, and/or their necessity for non-coextensive literature searches of the compounds (and methods of use thereof), restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

#### **Species Requirement**

Election of species should be required prior to a search on the merits in all applications containing both species claims and generic or Markush claims.(MPEP 808.01(a))

Upon election of any single one of the Groups from above, the following election of species is hereby required for the initial search for examination on merits:

The claims of Groups are generic to a plurality of disclose patentably distinct species of peptides which encompass a plethora of different compound species that require a burdensome classification, and/or bibliographic, manual and computer search. Accordingly, regardless of which group is elected, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (i.e., a single compound), even though the requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

To be complete, a response to the election of species requirement should include a proper election along with a listing of all claims readable thereon, including any claims subsequently added. MPEP 809.02(a).

Any inquiry concerning this communication from the examiner should be directed to Michael Borin whose telephone number is (571)272-0713. The examiner can normally be reached on 9 am-5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph.D., can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Michael Borin', with a long, sweeping horizontal line extending to the right.

Michael Borin  
Primary Examiner  
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mlb